REMARKS

This Request for Reconsideration is offered in response to the Office Action of August 26, 2004.

The Office Action rejected Claims 1-4 under 35 U.S.C. §103(a) as being obvious over the Applicant's allegedly admitted prior art in view of the DeWitt reference (U.S. Patent No. 5,212,733) (it is noted that Claims 2 and 4 were canceled in the prior response); rejected Claims 5 and 6 under 35 U.S.C. §103(a) as being obvious over the Applicant's allegedly admitted prior art in view of the DeWitt reference and further in view of the Suzuki reference (U.S. Patent No. 5,060,272); and rejected Claims 7 and 8 under 35 U.S.C. §103(a) as being obvious over the Applicant's allegedly admitted prior art in view of the DeWitt reference and further in view of the Suzuki reference and the Sparkes reference (U.S. Patent No. 4,993,073).

At the outset, the Applicant respectfully but strenuously traverses any assertion that the present invention is somehow made obvious, in whole or in part, by the statement " ... these audio mixers have a large number of dials and switches so that the operation of the controls has not been intuitive. In particular, there are effects which are frequently changed simultaneously, such as regeneration of the effect and the speed of the effect being used" (present application, page 1, penultimate sentence). It is further respectfully but strenuously submitted that the structure described in this passage is the prior art audio mixer with a "large number of dials and switches so that the operation of the controls has not been intuitive". There is no other description of any structure in this passage. Therefore, there is no "admission" of any other structure in this passage. In effect, the logic of this rejection appears to be that the description of the deficiency of the prior art (the awkward operation of the prior art) is somehow an admission of the solution of this deficiency. However, if this rejection relies upon a clear statement of the

deficiency of the prior art being an admission as to the solution, then this rejection relies upon the wisdom of hindsight gained after review of the disclosure, which is clearly inappropriate.

Applicant respectfully refers to MPEP 2143:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one ordinary skill in the art, to modify reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
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> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

Again, all that is found in the cited part of the application is a statement of the deficiency of a prior art mixer with "a large number of dials and switches". The Examiner may not use such a statement from the applicant's disclosure to find a teaching or suggestion of the applicant's invention (see the second paragraph of MPEP 2143 as set forth above). Thus the Office Action does not set forth a *prima facie* case of obviousness.

With the removal of the alleged admission as prior art, and further in view of the above-quoted claim language neither being disclosed nor suggested by the remaining cited prior art, alone or in combination, all of the above rejections are overcome.

In view of the above, each of the claims in this application is believed to be in immediate

condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to early issue.

Respectfully submitted,

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